



UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/372,560 08/11/99 VANCURA 0 1482/198 (A)

QM22/1106

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EXAMINER

PIERCE, W

ART UNIT

PAPER NUMBER

3711

23

DATE MAILED:

11/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/372,560

Applicant(s)

VANCURA, OLAF

Examiner

William M Pierce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 16 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30, 42-58 and 88-129 is/are pending in the application.
- 4a) Of the above claim(s) 88-129 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-30 42-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 7/16/01 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).


WILLIAM M. PIERCE
PRIMARY EXAMINER

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

The request filed on 7/16/2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/372,560 is acceptable and a CPA has been established. An action on the CPA follows.

Claims 1-30, 42-58 and 88-129 are rejected as being unduly multiplied. The nature and narrow scope of applicant's invention does not warrant 86 claims. The number of claims only serves to obscure the invention such that the examiner cannot be certain what applicant regards as his invention. The subject matter is capable of being claimed in 40 or less claims. Examiner attempted to reach Robert Dorr on November 1 and 2 of 2001, but no contact was made and no election of claims to be examined by this action was made. For the purposes of an action on the merits the application has been restricted to claims 1-30 and 42-59. If applicant wishes subject matter contained in claims 88-129 to be examined, such subject matter should be included in the examined claims. MPEP 2173.05(n) sets forth the basis for the rejection of the claims due to multiplicity;

37 CFR 1.75. Claim(s)

- (a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.
- (b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied...

An unreasonable number of claims, that is, unreasonable in view of the nature and scope of applicant's invention and the state of the art, may afford a basis for a rejection inasmuch as it relates to confusion of the issue. To avoid the possibility that an application which has been rejected on the ground of undue multiplicity of claims may be appealed to the Board of Patent Appeals and Interferences prior to an examination on the merits of at least some of the claims presented, the examiner should, at the time of making the rejection on the ground of multiplicity of claims, specify the number of claims which in his or her judgment is sufficient to properly define applicant's invention and require the applicant to select certain claims, not to exceed the number specified, for examination on the merits. The examiner should be reasonable in setting the number to afford the applicant some latitude in claiming the invention. The

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earlier views of the Court of Customs and Patent Appeals on multiplicity were set forth in *In re Chandler*, 254 F.2d 396, 117 USPQ 361 (1958) and *In re Chandler*, 319 F.2d 211, 225, 138 USPQ 138, 148 (1963) (Applicant's latitude in stating their claims in regard to number and phraseology employed "should not be extended to sanction that degree of repetition and multiplicity which beclouds definition in a maze of confusion."). These views have been somewhat revised by its views in *In re Flint*, 411 F.2d 1353, 1357, 162 USPQ 228, 231 (CCPA 1969) ("The [42] claims differed from one another and we have no difficulty in understanding the scope of protection. Nor is it clear, on this record, that the examiner or board was confused by the presentation of claims in this case or that the public will be.") and *In re Wakefield*, 422 F.2d 897, 902, 164 USPQ 636, 639 (CCPA 1970) ("Examination of forty claims in a single application may be tedious work, but this is no reason for saying that the invention is obscured by the large number of claims. We note that the claims were clear enough for the examiner to apply references against all of them in his first action."). If a rejection on multiplicity is in order the examiner should make a telephone call explaining that the claims are unduly multiplied and will be rejected on that ground. Note MPEP § 408. The examiner should request selection of a specified number of claims for purposes of examination.

The applicant's reply to a formal multiplicity rejection of the examiner, to be complete, must either:

(A) reduce the number of claims presented to those selected previously by telephone, or if no previous selection has been made to a number not exceeding the number specified by the examiner in the Office action, thus overcoming the rejection based upon the ground of multiplicity, or (B) In the event of a traverse of said rejection applicant, besides specifically pointing out the supposed errors of the multiplicity rejection, is required to confirm the selection previously made by telephone, or if no previous selection has been made, select certain claims for purpose of examination, the number of which is not greater than the number specified by the examiner. If the rejection on multiplicity is adhered to, all claims retained will be included in such rejection and the selected claims only will be additionally examined on their merits.

This procedure preserves applicants' right to have the rejection on multiplicity reviewed by the Board of Patent Appeals and Interferences. Also, it is possible to reject one claim on an allowed claim if they differ only by subject matter old in the art. This ground of rejection is set forth in *Ex parte Whitelaw*, 1915 C.D.

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18, 219 O.G. 1237 (Comm'r Pat. 1914). The Ex parte Whitelaw doctrine is restricted to cases where the claims are unduly multiplied or are substantial duplicates. Ex parte Kochan, 131 USPQ 204, 206 (Bd. App. 1961).

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 2, 4-7, 11-17, 19-30 and 42-58 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 19, 24, 25, 30, 42, 43, 47-50, 55 and 56 of copending Application No. 09/875,753. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, 8-10 and 18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the copending claims Application No. 09/875,753. Although the conflicting claims are not identical, they are not patentably distinct from each other because the terms "separate" and "incombination" do not clearly distinguish the scope of one claim from that of another. A predetermined range called for in the house percentage claim 1 of the '560 application is inherent to the design of a wagering game to having a favorable house percentage. The design of wagering games having house percentages are inherent and well known to one skilled in the art. The examiner's position for such being well known is set forth in the following grounds for rejection and response to applicant's remarks.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-30 and 42-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker.

As to claims 1-4, 12, 13, 19, 20, 25-30, 42, 43-47, 50, 51, 57 and 58, Walker clearly shows the wager, game of chance and trivia game. He discloses his play of the trivia game to occur "while the reels are spinning" (col. 3, ln. 26). Such is considered to be "separate" from the play of the game of chance. Claims 9-11, 48, 49 and 56 are inherent since a game designer must determine and be aware of the "desired profitability" of the game he is designing. Scarne's Complete Guide to Gambling discusses house percentage and how a gaming operator would make or lose money by making determinations that affect house percentage (conventionally the house pays off a wager at less than the correct odds. A favorable house percentage that considers the level of skill of the players (i.e. the correctness of the answers) is inherent. See discussion in the paragraph below and in response to applicant's remarks made in the preliminary amendment.

Claims 1-4, 9-30 and 42-58 are rejected under 35 U.S.C. 102(b) as being anticipated by 2,262,642.

As to claims 1-4, 12, 13, 19, 20, 25-30, 42-47, 50, 51, 57 and 58, shown is a slot 10 for receiving a wager, a casino slot machine and a trivia game (discussed on the bottom of his page 3) that is played separate and after the casino game. A favorable house percentage that considers the level of skill of the players (i.e. the correctness of the answers) is inherent. See discussion below in response to applicant's remarks made in the preliminary amendment. In line with this claims 9-11, 48, 49 and 56 are inherent since a game designer must determine and be aware of the "desired profitability" of the game he is designing. Scarne's Complete Guide to Gambling discusses house percentage and how a gaming operator would make or lose money by making determinations that affect house percentage (conventionally the house pays off a wager at less than the correct odds. However, the rules of play,

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such as a "push" or allowing the determination of a players hand in blackjack before the determination of the dealer can also affect the house percentage). Inherently all gaming operators avoid losing money. Clearly no operator of the '642 method would consider losing money. One must consider such is a matter of common knowledge and common sense of the person of ordinary skill in the art to consider the level of skill of a player as a variable in the conventional house percentage of the combined wagering game. (See *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)) Note 2,253,569 at the bottom of pg. 2 that shows that one skilled in the art of trivia game is concerned with "loss of income from Skill with Prize machines due to over-skilful players..." Knowing that the over skilled player can result in a loss of income is considered to be part of the skill that is presumed on the part of those practicing in the wagering machine art. See *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). In evaluating a reference, it is proper to take into account not only the specific teaching of the reference(s) but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In *re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). In the instant case, the consideration of house percentage, so that a game makes money without decreasing player interest, is at the root of every wagering game. Additionally, one must observe that an artisan must be presumed to know something about the art apart from what the references disclose (see *In re Jacoby*, 309 F.2d, 513, 516, 135 USPQ 317, 319 (CCPA 1962)). Clearly, an artisan would realize that a favorable house percentage would have to be designed for a game to make money in a casino environment. Claims 14-18, 21-24 and 52-55 are drawn to quiz games. Examiner submits that such gaming formats are old and well known and inherent in the disclosure of '642.

Claims 1-7, 12, 13, 18, 42-46, 50, 55, 57 and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by Keller and, in the alternative 2,197,974.

Claims 1-4, 41-46, 50, 57 and 58 are clearly shown. In Keller, a player places a wager and receives a payout in tokens like a standard casino game. However, the tokens are not given any cash value and are only good for chances to play the game of skill. Specifically turning to claim 1, the steps of "receiving a wager" are shown in fig. 1 of Keller by "players can place stake in a casino game", "playing an underlying game of chance" is shown by "conduct casino game" and "playing a knowledge-based bonus game." by "conduct skill game. The house advantage is at the bottom of col. 2, lns 61-67 where a player is played "for the entertainment". The house advantage is nothing more than a percentage of the wager retained by the house for the privileges of playing the games. In view of the

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above, Keller meets the limitations of the claims. In Keller and '974, the game of chance stops when a prize has been determined or rewarded. At that point, the game of skill commences. As to claim 5, stopping the game of chance when the condition of a prize being identified is shown. As to claim 6, the game of chance stops at the end of the game. The end of each game of chance is considered to be a "given frequency" as called for in claim 7. As to claims 12 and 13, a player is "paid" a prize in Keller and '974. Claims 18, 41 and 55 are shown in that a player is paid a first prize if correctly answers and receives a second amount of no prize if incorrectly answers

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-11, 14-17, 19-30, 47- 49, 51-54, 56 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller and/or 2,197,974 in view of Thompson.

As to claims 8 and 47, neither of the above references show random stopping of the chance game. Thompson teaches that it would have been obvious to random conduct the steps of a game like those shown by Keller and '974 in order to add an element of surprise to the players. The setting of the house advantage in claim 9-11, 19, 20, 25-30, 48, 49 and 56 are obvious matters of design choice. As to claims 14, 21 and 22, it is considered an obvious matter of design choice to require either an exact answer or a proximate answer that is "close enough". Similarly, allowing a player to have more than one chance to answer a query and paying out accordingly as called for in claim 63 is old and not considered an advance in the art. To have only required a proximate answer in Keller of '974 would have been obvious in order to make it easier on the player. As to claims 15-17, 23 and 51-54, Keller and '974 show "trivia" and a "quiz". Multiple choice, puzzles and true/false questions are all well known examples of such trivia or quiz type games of skill that are known in the art and to have selected one would have been an obvious

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matter of design choice. Claim 24 is shown in that a player is paid a first prize if correctly answers and receives a second amount of no prize if incorrectly answers.

Response to Arguments

Applicant's arguments filed 7/16/2001 have been fully considered but they are not persuasive.

Applicant's remarks with respect to the rejections made under 112 and the drawings are noted as overcome.

With respect to the rejection made under 102. Applicant takes the position that the prior art does not have "a casino game with a house advantage in a predetermined range". As set forth above in the grounds of rejection, the consideration of a house advantage or house percentage is very old and inherent in all casino games. Scarne's discusses such considerations. One skilled in the art is obviously aware that a casino game cannot be designed to lose money. So the game is designed with odds that favor the casino. Opposing this effort to make money on the game is an awareness that the players interest must not be lost. A game having too high of a house percentage will not be played by players and will be considered a "sucker bet". A house percentage in a game is a matter of choice for a casino. A house could reap large profits from paying off bets made at only 5 to 1 where the true odds are 10 to 1. However, almost all players would avoid such bets. Hence a house would choose to pay off wagers at 9 to 1. Known too is that the rules of the game can give a house advantage. Such is the case with black jack where a players cards played before the dealers and a "push" declared for like hands. In considering the house percentage, all variables in playing the game are considered by one skilled in the art. In applicant's invention, he has the variables of the known wagering game as well as the skill of the player. It is obvious in game of skill that a smarter player reduces the house advantage (such also occurs with the game of black jack that has an element of skill). Obviously a house would want to protect themselves from the "smarter" player and design the house percentage such that no money would be lost. If such was the case then the "smarter" player could "play the house percentage" and always make money from the house. Such weaknesses in a casino game where players may be able to always win money are inherent in the design of a game. Applicant bases the allowability of his claims on what he considers his "discovery" in allowing a house to always make money on a wagering trivia game. This is set forth at the top of pg. 9 of his specification as quantified in a formula having all the known variables in the designed game. Merely expression what is inherent in the art as a formula is not a patentable advance.

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The examiner's position is supported in that "in determining whether the invention as a whole would have been obvious under 35 U.S.C. 103, we must first delineate the invention as a whole. In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question... but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the specification. . . . Just as we look to a chemical and its properties when we examine the obviousness of a composition of matter claim, it is this invention as a whole, and not some part of it, which must be obvious under 35 U.S.C. 103." In re Antonie, 559 F.2d 618, 620, 195 USPQ 6,8 (CCPA 1977). Since an extra reference or evidence can be used to show an inherent characteristic of the thing taught by the primary reference (MPEP 2131.01), Scarne's and 2,253,569 have been used in the grounds for rejection. "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Finally, held is that SOMETHING WHICH IS OLD DOES NOT BECOME PATENTABLE UPON THE DISCOVERY OF A NEW PROPERTY. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See MPEP § and MPEP § 2141.02 with regard to inherency and rejections under 35 U.S.C. 103.

Applicant's next argument is that the prior art does not show "a first game of chance with a negative player's expected return and a second knowledge-based game having a having a positive player's expected return." Such is not persuasive since such limitations are inherent in the prior art as set forth in the examiner's position above. First, as set forth above, it is old to design games of chance with "negative player's rates of return". Designing them any other way would result in a game that loses money for the casino. Lastly, when games are combined with a casino games (Marnell, DiRe et al. and 2, 262,642) the game combined is used to allow a player to increase his winnings. They are to entice a player to play or continue to play. They can serve to augment a players winnings (rather than diminish them) or risk a players winnings from the previous game in a "double or nothing" format. See pg. 12, ln. 13 of 2,262,642.) Having a positive player's expected return on the second game would allow a player to increase his winnings more often than not and a player have more interest. The contrary is true if the second game hand a negative player's expected return, he would lose more often than not when playing the second game and would have little interest in ever playing the second component of the game or the entire combined game itself. In short, merely claiming the obvious which has been silently inherent in the prior art is not considered a patentable advance.

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Applicant attacks Keller as "Keller is not a casino game" (bottom of pg. 20). Examiner disagrees since even in his abstract, Keller states that "stakes in the casino game are placed with chips which may be purchase in exchange for the service of conducting the casino game. A winning stake is rewarded a token..." He clearly has an expected rate of return of a token. He then can increase this token by engaging in the game of skill where he is paid in cash. Hence there is a separate play and a separate expected return contrary to applicant's remarks.

Keller clearly has a house advantage. For example, the house may decide to pay a player of Keller's game more than one token when winning a game of chance. This would give a player a greater number of opportunities to win money at the games of skill resulting in a lower house percentage. Contrary to this example, a player may have to afford a plurality of tokens won at the game of chance to enter the game of skill thereby decreasing the number of opportunities that he would have to win money. Such a scenario would increase a house percentage. Hence, as shown by the examples above, one skilled in the art can design the game of Keller to produce any desired house percentage.

As to claims 5-7, combining various games with known wagering game is old. How a player participates in one game or another can occur at random, by a predetermined event or at particular intervals. Applicant has not set forth any new way that combined games are played. As set forth above, 2,262,642 shows such manners of participating between two combined games.

Applicant's remarks with respect to the rejection under 103 are based on the same issues set forth under 102. Examiner position is set forth above and no further comment is deemed necessary.

As to the declarations, it is recognized that applicants who allege they discovered the source of a problem must provide evidence substantiating the allegation, either by way of affidavits or declarations, or by way of a clear and persuasive assertion in the specification. In re Wiseman, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979) (unsubstantiated statement of counsel was insufficient to show appellants discovered source of the problem); In re Kaslow, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983). Examiner's position is that house advantage and the designing of wagering games with it in mind are old and well known to one skilled in the art. Basis for this position is set forth above. Mr. Vancura's status in the field of gaming is well recognized by the examiner. However, this invention does not require "complex mathematics" (referring to function shown at top of pg. 9 of specification). Such is simply a quantification of all that is known and old to the consideration of house percentage in the design of a wagering game. A mere declaration stating that what is old and well known is non-obvious is not sufficient to overcome the grounds for rejection. Applicant makes that statement that "until his invention, it was not known how to handle responses based on the knowledge of a player". However, there is no evidence to support such a statement.

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The contrary is true supported by 2,253,569 that discusses how to "handle" the "over-skilful players" at the bottom of his pg. 2. While Mr. Vancura's statements are regarded well they amount to what one skilled in the art would have considered when facing the problem of setting a house percentage in games like those of Walker, Kelly or '642. Hence the examiner's position is that applicant has done nothing more than what would have been obvious to one skilled in the art considering making his game profitable and defining a house percentage.

Predetermined range of set limits in a house percentage are old. As set forth above these limits are a consideration of how much money the game will generate verses the amount of player interest. The statement that "knowledgeable players may bankrupt the house" is plainly obvious even to one of less than ordinary skill in the art. For example a trivia game played at even odds would lose money on any player that gets over half of the questions correct. Clearly, for a stand alone wagering trivia game the applicant's statements would be true since any odds offered by a house in a stand alone game would lose to a player who correctly answered all questions all the time. The UK machines address this issue by varying the odds, time to respond or difficulty based on a players performance. Examiner understands that by combining a trivia game with a casino game, applicant recognizes the play of a trivia game in a casino format that does not vary based on a players performance (which is construed as unlawful in certain States as it pertains to gaming machines). However, trivia games combined with casino games are known as set forth by the prior art applied in the rejection above.

As set forth above, the setting of limits based on answers "always being correct" is plainly obvious. This is the "worst case scenario". One skilled in the art would surely consider such when setting the house percentage.

Likewise, setting the limits based on guesses considers the interest a non-skilled player would have in playing the game. If the house percentage "worked" too great against such a player then no interest in playing the game would exist. Clearly, a game designer wants his game to appeal to "all types of players". Expected is that as a player obtains more knowledge (or recognizes questions previously posed) he will decrease the house advantage. Such a situation is similar to the one in black jack were a non-skilled player pays a higher house percentage and this percentage is decreased as he learns the game (see Scarne's).

As set forth above, the two set limits is inherently obvious to one of ordinary skill in the art. Both the players and the house recognize a "reasonable rate of return". If the house is unreasonable then the player loses interest. If the house is too reasonable then it goes broke.

The arguments pertaining to the House Advantage Formula are moot in view of the multiplicity rejection above. Merely rephrasing the claims to recite a quantified formula as opposed to a function only obscures the invention and confuses the prosecution.

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As set forth above, it is known in games combined with casino games to allow a player to risk or augment his winnings. A player that attempts to augment his winnings by playing a second game would still receive his initial winnings as a payoff. A game designer has many choices to entice play in games like Kelly, Walker or '642. The second game of skill can double ones winnings if he prevails with no risk to merely add a greater degree of interest in the game or in other situations a subsequent wager would be required (such a in known jackpot wagers) where only that wager is at risk and not an original wager. In any event, it is clearly obvious to one skilled in the art that if the likelihood of a player winning would always be decreased by the game of skill, a player would have little interest in the game (or continuing on to the second component if a choice was offered).

The declaration of Mr. Grochowski is subjective and fails to set forth facts. All statements are in his "belief" or "surprising" to him. While an experts opinion carries some weight, it does not carry enough weight to overcome the grounds for rejection above.

Likewise the declaraion of Gushin merely states that he has never seen a game like "Ripley's Casino Game". Such is an opinion based on experience and not a matter of fact.

Conclusion

Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address bill.pierce@USPTO.gov or at telephone number (703) 308-3551.


Any inquiry not concerning the merits of the case such as **missing papers, copies, status or information** should be directed to Tech Center 3700 Customer Service Center at (703) 306-5648 where the fax number is (703) 308-7957 and the email is Customerservice3700@uspto.gov.

For **official fax** communications to be officially entered in the application the fax number is (703) 305-3579.

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